

## DETAILED ACTION

### *Election/Restrictions*

1. Claim 40 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/16/2009.
2. Applicant's election of Group 1 and Species 2 of Category 1 and Species 1 of Category 2 in the reply filed on 7/16/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claim 25 is further withdrawn as being drawn to Fig. 5 which is specific to Species 2 of Category 2.
4. Claim 32 is further withdrawn as being drawn to Fig. 2 which is specific to Species 1 of Category 1.
5. Claim 37-39 are further withdrawn as being drawn to Fig. 6A which is specific to Species 3 of Category 2.

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plugs

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closing the ends of the first cavity must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

***Claim Objections***

3. Claim 24 objected to because of the following informalities: delete the "4" after the "23". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[Claim 20] The term "prismatic" is indefinite. It is not understood how a profiled bar is prismatic.

[Claim 20] The phrase "said holes" is indefinite. Did Applicant mean to say "said at least one continuous hole"?

[Claim 20] The phrase "said profiles are identical and mirror-symmetrical" is indefinite. The profiles are not identical and mirror-symmetrical because one of the profiles has the at least one continuous hole whereas the other profile does not. Did Applicant mean to say wherein "each of said profiles is symmetrical about a vertical axis"?

Applicant appears to use the term "which" to precede limitations (i.e. "which bar", "which internal cavity"), this is be changed to "said" or "the" (i.e. "said bar", "said internal cavity"). Applicant is advised to review all the claims and make appropriate changes.

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6. Regarding claims 20 and 30-35, the phrases "such as" and "for instance" 'preferably' render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. Regarding claim 20, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

8. Claim 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wood-like material" is indefinite. Examiner does not understand how a material can be "wood-like". An object either is wood or it isn't.

9. Claim 28 recites the limitation "the plane of symmetry". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 is dependent upon claim 26 which is a cancelled claim. Did Applicant mean to change the dependency to Claim 20?

11. Claim 31 recites the limitation "the same shaft". There is insufficient antecedent basis for this limitation in the claim.

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12. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “prismatic” in claims 20 and 22 is used by the claim to mean “a form in which the cross-section is the same at any position”, while the accepted meaning is “of, pertaining to, or like a prism.” The term is indefinite because the specification does not clearly redefine the term.

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant has defined the term “prismatic” as meaning “a form in which the cross-section is the same at any position”; however it is not understood what this means. Is the Applicant saying that the cross-section is the same at any position in that it comprises the same material at any point in the cross-section? What is the reference plane? In claim 20, how is a first cavity ‘preferably prismatic’,—prismatic has been defined as a

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term relating one object to another.

[0008] A specific embodiment can have the special feature that the two profiles are prismatic. "Prismatic" is understood to mean a form in which the cross-section is the same at any position.

If the 2<sup>nd</sup> cavity is

prismatic, is it to be assumed that means with respect to the 1<sup>st</sup> cavity and vice-versa?

15. Claim 30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to describe how the profiles are non-releasably connected to each other.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Haller (DE 3135790 A1).**

**[Claim 20] As best understood by the Examiner ...** Haller discloses a profiled bar comprising:

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an internal first cavity (Fig. 3) which extends in the longitudinal direction of the bar capable of accommodating a raising mechanism, Said internal cavity is accessible from the exterior via at least one continuous hole (see where 25 is) in the bar, said at least one continuous hole capable of allowing passage of at least one control cord;

at least one second cavity (4a) which extends in the longitudinal direction of the bar and which opens via a constriction onto the outside of the bar, said second cavity serves to receive the upper edge of a covering (Fig. 3) which is embodied such that it fits into the second cavity but is too thick to pass through the constriction; and

two mutually coupled profiles (1, 3) which together bound the first cavity, wherein at least one of the profiles has the at least one continuous hole, wherein each of said profiles is symmetrical about a vertical axis (Fig. 3).

**[Claim 23]** Haller discloses wherein both ends of the bar having a respective opening (Fig. 1) which connects to the first cavity, said respective openings are each closed by a respective plug (22).

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**19. Claims 21, 22, 24, and 33-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Haller (DE 3135790 A1).**

**[Claim 21]** *As best understood by the Examiner ...* Haller fails to disclose wherein the profiles consist of wood.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the profiles consist of wood, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

**[Claim 22]** *As best understood by the Examiner ...* Haller discloses wherein the two profiles comprises the same material at any point in the cross-section (Fig. 3).

**[Claim 24]** Haller fails to disclose wherein the plugs consist of the same material as the two profiles.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the plugs consist of the same material as the two profiles, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

**[Claim 36]** Examiner notes that Claim 36 is a product-by-process claim.

Examiner notes the method of forming an apparatus is not germane to patentability of apparatus itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not



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depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

### **MPEP 2113 [R-1] Product-by-Process Claims**

PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE IMPLIED BY THE STEPS

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product.).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art,

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especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

ONCE A PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS FOUND AND A 35 U.S.C. 102 /103 REJECTION MADE, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN UNOBVIOUS DIFFERENCE

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (The claims were directed to a zeolite manufactured by mixing together various inorganic materials in solution and heating the resultant gel to form a crystalline metal silicate essentially free of alkali metal. The prior art described a process of making a zeolite which, after ion exchange to remove alkali metal, appeared to

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be "essentially free of alkali metal." The court upheld the rejection because the applicant had not come forward with any evidence that the prior art was not "essentially free of alkali metal" and therefore a different and unobvious product.). Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (The prior art disclosed human nerve growth factor (b-NGF) isolated from human placental tissue. The claim was directed to b-NGF produced through genetic engineering techniques. The factor produced seemed to be substantially the same whether isolated from tissue or produced through genetic engineering. While the applicant questioned the purity of the prior art factor, no concrete evidence of an unobvious difference was presented. The Board stated that the dispositive issue is whether the claimed factor exhibits any unexpected properties compared with the factor disclosed by the prior art. The Board further stated that the applicant should have made some comparison between the two factors to establish unexpected properties since the materials appeared to be identical or only slightly different.).

#### THE USE OF 35 U.S.C. 102 /103 REJECTIONS FOR PRODUCT-BY-PROCESS CLAIMS HAS BEEN APPROVED BY THE COURTS

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a

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product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable.

As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

## II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

### 2173.05(q) "Use" Claims

Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." was held

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to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

Other decisions suggest that a more appropriate basis for this type of rejection is 35 U.S.C. 101. In Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was definite, but that it was not a proper process claim under 35 U.S.C. 101: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid." Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

**[Claim 33]** Haller fails to disclose wherein the profiles consist of a transparent material.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the profiles consist of acrylic, polycarbonate or plexiglass, since it has been held to be within the general skill

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of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

**[Claim 34]** Haller fails to disclose wherein the profiles consist of a metal.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the profiles consist of aluminum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

**[Claim 35]** Haller fails to disclose wherein the profiles consist of a an opaque plastic

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the profiles consist of PVC, PP or PE, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

**20. Claim 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Haller (DE 3135790 A1) in view of Hwang (US 6,543,516).**

**[Claim 28]** *As best understood by the Examiner* ... Haller discloses wherein two profiles are mutually coupled.

Haller fails to disclose the two profiles coupled in a plane of symmetry extending through the prismatic second cavity.

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Hwang teaches a substantially symmetrical bar (Fig. 8) having a first cavity (Fig. 8 - see cavity on right), a second cavity (Fig. 8 - see cavity on left), and a constriction (211'). It would be obvious to one of ordinary skill in the art to move the constriction (211') of Hwang to the center so that the bar is symmetrical; the motivation for doing so would be for a more aesthetically pleasing look.

The combination of Haller and Hwang would teach the two profiles mutually coupled in a plane of symmetry, said plane of symmetry extending through the second cavity.

It would be obvious to one of ordinary skill in the art at the time the invention was made to apply Hwang's teachings to Haller's device. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (*Nerwin v. Erlichman*, 168 USPQ 177, 179); further the motivation for doing so would be to more easily assemble and install a raising mechanism inside the bar.

**21. Claim 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Haller (DE 3135790 A1) in view of Toti (US 5,323,834).**

**[Claim 29]** Haller fails to disclose wherein the edge of the at least one hole is rounded.

Toti teaches a hole with a rounded edge (Fig. 24; see 211).

It would be obvious to one having ordinary skill in the art at the time the invention was made to apply Toti's teaching to Haller's device; the motivation for

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doing so would be to prevent fraying of a cord and to allow a cord to pass over the edge more smoothly.

**22. Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Haller (DE 3135790 A1) in view of Peterson et al. (US 5,195,569).**

**[Claim 30] As best understood by the Examiner ...** Haller fails to disclose wherein the profiles are connected non-releasably to each other.

Peterson teaches two profiles (Fig. 4 - see 40 and 134) that are connected non-releasably to teach other (via 135).

It would be obvious to one of ordinary skill in the art at the time the invention was made to apply Peterson's teaching to Haller's device; the motivation for doing so would be to provide a more secure connection between the two profiles that is less likely to break under the weight of the profiles (Peterson – Col. 9, lines 43-50).

**23. Claim 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Haller (DE 3135790 A1) in view of Judkins (US 6,964,291 B2).**

**[Claim 31] As best understood by the Examiner ...** Haller teaches a raising mechanism (Fig. 1)

Haller fails to disclose a drive roller and wind-up rollers.

Judkins teaches a raising mechanism (Fig. 4) comprising:

a drive roller (25) onto which a control cord (26) engages for rotating driving thereof; and

a number of wind-up rollers (28) for raising cords (27) which are connected to the drive roller via a shaft (24).



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It would be obvious to one of ordinary skill in the art at the time the invention was made to apply Judkins' teaching to Haller's device; the motivation for doing so would be to prevent tilted raising of the covering.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of Reference Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILIP S. KWON whose telephone number is (571)270-5230. The examiner can normally be reached on Mon - Fri 7:30-5, every other Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on (571)272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Philip S Kwon/  
Examiner, Art Unit 3634

/KATHERINE W MITCHELL/  
Supervisory Patent Examiner, Art  
Unit 3634